

REMARKS

This Application has been reviewed in light of the Office Action mailed May 16, 2007. At the time of the Office Action, Claims 1-9, 11, 12 and 24-26 were pending in this Application. Claims 1-9, 11, 12 and 24-25 were rejected. Claims 10 and 13-23 were previously cancelled without prejudice or disclaimer. Claim 26 has been allowed. Claim 9 has been amended. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1-9, 11-12 and 24-25 were rejected by the Examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,156,056 issued to Kearns et al. ("Kearns"). Applicant respectfully submits that Kearns does not anticipate the rejected Claims because Kearns does not show all the elements in the Claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

Independent Claim 1

With respect to Claim 1, Kearns does not disclose a device with a first configuration and a second configuration "characterized by said outer peripheral wall being radially enlarged at a point along said longitudinal axis such that said apparatus has a larger cross section in said second configuration than in said first configuration at said point." The office action contends such a second configuration is shown "to the left side of element 428 of fig. 24 has an enlarged cross section along the longitudinal axis." Office action, page 4.

Applicant submits that the embodiment of fig. 24 of Kearns shows a suture buttress in a first, unbent position. See Col. 7, lines 46-48. The limitation in question requires a comparison of the apparatus between a first configuration and a second configuration. Thus, the office action's reference to only the first, unbent configuration of the Kearns suture buttress cannot not disclose the cited limitation. Further, after the Kearns suture buttress is manipulated into a bent position, as shown in Figure 25, the suture buttress will bend about its longitudinal axis and will not have undergone any significant radial expansion. The arrangement of slits 418 and 428 promote this

bending about the longitudinal axis but clearly do not facilitate or result in any radial expansion about the longitudinal axis as recited in Claim 1.

Dependent Claim 6.

Claim 6 depends from Independent Claim 1 and recites that the slits of Claim 1 are “generally parallel to said longitudinal axis.” The office action does not specifically address this limitation except for the general assertion: “As to claims 4-25, Kearns disclose in figures 1, 23-25, abstract and col. 3, lines 50-62 an apparatus for attaching tissue to bone having the limitations described above.” Applicants note that the slits 40 shown in Figure 1 are disposed at an angle with respect to the longitudinal axis and that slits 418 and 428 shown in Figures 23-24 are generally perpendicular to the longitudinal axis of the suture buttress of Kearns. Accordingly, Applicants submit that Kearns also does not disclose slits generally parallel to the longitudinal axis, as recited in Claim 6.

Dependent Claim 9.

Claim 9 also depends from Independent Claim 1. As recited, Claim 9 recites that the “plurality of spaced slits comprises at least six slits disposed about the circumference of said outer peripheral wall.” Emphasis added. In contrast, the suture buttress of Kearns discloses slits along either one side (see Figure 1) or two opposites sides (see Figures 23-25) of the device and does not disclose multiple adjacent slits disposed around the circumference of the device as recited.

Independent Claim 11.

Independent Claim 11 was also generally rejected but with no specific discussion or explanation thereof. Similar to Claim 6, above, Claim 11 recites an apparatus including a “body including a plurality of spaced slits longitudinally disposed about said outer peripheral wall...” As discussed above, Kearns does not disclose longitudinal slits.

For at least these reasons Applicants submit that Kearns cannot anticipate Independent Claims 1 or 11 or Claims 2-9, 12, 24 and 25 that depend therefrom. Applicants request reconsideration, withdrawal of the rejections under §102 and full allowance of Claims 1-9, 11-12 and 24-25.

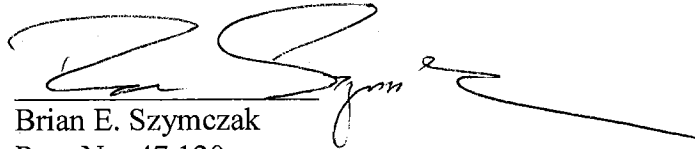
CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Commissioner is hereby authorized to charge any fees necessary for the extension of time, RCE or other necessary fees or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.391.3961.

Respectfully submitted
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